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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,487	06/23/2003	Daniel Castro	50623.305	6004

7590 07/31/2006

Paul J. Meyer, Jr.
Squire, Sanders & Dempsey L.L.P.
1 Maritime Plaza, Suite 300
San Francisco, CA 94111

EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,487

Applicant(s)

CASTRO ET AL.

Examiner

Jennifer K. Michener

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 94-183 is/are pending in the application.
- 4a) Of the above claim(s) 164 and 176 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 94-163, 165-175, 177-183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 94-163, 165-175, and 177-183 under 35 U.S.C. 112, second paragraph, as being indefinite is maintained.

Claim Rejections - 35 USC § 102

2. Claims 110, 111, 114, 117, 118, 119, 120, 125, 126, 132, 156, and 159 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuch (5,679,400).

Examiner maintains the rejection of the most recent office action.

Claim Rejections - 35 USC § 103

3. Claims 94-95, 98, 101, 102-103, 109, 130, , 140, 141, 154, 158, 159-163, 165-167, 172-175, and 177-179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuch.

Examiner maintains the rejection.

Response to Arguments

4. Applicant's arguments filed 5/24/2006 have been fully considered but they are not persuasive.

Applicant argues that the coating step is not critical or essential to the invention and that Examiner may only reject a claim for lacking a critical or essential step when language

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from the specification makes it clear that the limitation is critical or essential for the invention.

Examiner notes that all method embodiments throughout the specification require application of a coating substance. For example, starting on p. 24 in "A Method for Coating a Prosthesis" section, several embodiments are outlined for moving a dispenser while **depositing** a composition, moving the holding assembly while **depositing** a composition; **depositing** a composition in a pattern or **depositing** it intermittently, etc. In fact, the entire method is directed to a process for coating, as evident from the title, method heading, description, and drawings.

Applicant argues, with regard to the 112 rejections, that Examiner is incorrect in requiring the claims to include an active step of applying a coating because Applicants do not specify that application of a coating is critical or essential for the claimed invention. However, Applicant also argues that Examiner's art rejection logic "would reach the absurd conclusion that stopping spraying altogether means avoiding spraying onto the stent".

Such a conclusion is not absurd. In the absence of an active coating step in the claimed invention, a lack or stoppage of spraying would avoid coating the spaces and the stent and, as such, would still meet the claim limitations, as outlined in the previous action.

Applicant cannot have it both ways. If, as Applicant argues, a coating step is not part of the claimed invention, then Examiner need not find a reference with a coating step to

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meet the limitations of the claims. A reference that involves movement of a dispenser and avoidance of application of coating meets the claims. As outlined in the previous office action, claim 94, for example, merely requires causing a dispenser to be moved along a path defined by a pattern... such that the dispenser avoids application of the coating substance in a space between the frame structures. Examiner has cited a reference which teaches, in one embodiment, movement of a dispenser in such a way as to avoid application in a space between the frame structures. For that period of time, no material is applied to the stent, the spaces, or anywhere else, however, that does in fact meet the limitations of the claims, as written.

Again, Examiner notes that “for the application of the coating substance” is merely intended use. Even so, Tuch does move his dispenser for subsequent application of a coating substance.

The Tuch reference, in the second embodiment, teaches coating only one end. Clearly, all the spaces at the other end of the stent are avoided. The claims, as written, require only avoidance of the substance in “a space”. The claim is open to application of coating substances through hundreds of spaces, as long as one single space is avoided.

Examiner has merely taken claims directed to moving a dispenser at face value. It is noted that the art rejections clearly demonstrate why the claims, as written, are more broad than what Applicant’s arguments seem to imply and specification states is the invention.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer K. Michener whose telephone number is (571) 272-1424. The examiner can normally be reached on Monday through Thursday and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jennifer K. Michener
Primary Examiner
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